



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Patent and Trademark Administration
Washington, DC 20590
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 928,810	08 13 2001	James J. Lalonde	1690A1	8220

7590 04 14 2003

PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
Pittsburgh, PA 15272

EXAMINER

MARX, IRENE

ART UNIT PAPER NUMBER

1651

DATE MAILED: 04 14 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

. Office Action Summary

Application No.

09/928,810

Applicant(s)

LALONDE, JAMES J.

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1 ☐ Certified copies of the priority documents have been received.
2 ☐ Certified copies of the priority documents have been received in Application No. _____.
3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other: _____

Art Unit: 1651

Applicant's election with traverse of Group I, claims 1-15 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that because the reaction mixture has an intended use of "for producing 2-oxoglutaramate" it cannot be used in a materially different process than the process recited in claims of group I. However this is not found persuasive because applicant has not demonstrated with objective evidence that the composition as claimed cannot be used to produce other products, such as single cell protein for nutritional supplementation or other enzymatic products, as noted in the restriction requirement. Also there is a clear difference in scope between claims directed to a process of using an active biocatalyst derived from *Proteus* or *Providencia* and claims directed to bacteria of the genera *Proteus* or *Providencia* in conjunction with 20 mM of 2-oxoglutaramate and the references which would be applied to one method would not necessarily anticipate or render obvious the composition.

Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exists.

Clearly different searches and issues are involved with each group.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL.

Claims 16-30 are withdrawn from consideration as directed to a non-elected invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 4 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ specific strains of *Providencia* and *Proteus*. It is not clear if the written description is sufficiently repeatable to avoid the need for a deposit. Further it is unclear if the starting materials were readily available to the public at the time of invention.

Art Unit: 1651

It appears that a deposit was made in this application as filed as noted on page 5 of the specification. However, it is not clear if the deposit meets all of the criteria set forth in 37 CFR 1.801-1.809. Applicant or applicant's representative may provide assurance of compliance with the requirements of 35 U.S.C § 112, first paragraph, in the following manner.

SUGGESTION FOR DEPOSIT OF BIOLOGICAL MATERIAL

A declaration by applicant, assignee, or applicant's agent identifying a deposit of biological material and averring the following may be sufficient to overcome an objection and rejection based on a lack of availability of biological material.

1. Identifies declarant.
2. States that a deposit of the material has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.
3. States that the deposited material has been accorded a specific (recited) accession number.
4. States that all restriction on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.
5. States that the material has been deposited under conditions that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 CFR 1.14 and 35 U.S.C § 122.
6. States that the deposited material will be maintained with all the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty (30) years after the date of deposit for the enforceable life of the patent, whichever period is longer.
7. That he/she declares further that all statements made therein of his/her own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Alternatively, it may be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the purpose of Patent Procedure (e.g. see 961 OG 21, 1977) and that all restrictions on the

Art Unit: 1651

availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.

Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession) number, date of deposit, name and address of the depository and the complete taxonomic description.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6 and 9-13 are incomplete in the absence of a recovery step for the product produced. While there is no specific rule or statutory requirement which specifically addresses the need for a recovery step in a process of preparing a composition, it is clear from the record and would be expected from conventional preparation processes that the product must be isolated or recovered. Thus, the claims fail to particularly point out and distinctly claim the "complete" process since the recovery step is missing from the claims. The metes and bounds of the claimed process are therefore not clearly established or delineated. Claim 1 is confusing in the recitation of "a biocatalyst derived therefrom", since it is unclear whether the "biocatalyst" derived by chemical, physical or biological means. Amendment to -- obtained from-- would be remedial.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: -

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meister taken with Swajeer *et al.*

Art Unit: 1651

Meister discloses the enzymatic production of 2-ketoglutaramate from L-glutamine (See, e.g., page 575, last paragraph). Note also the use of purification by ion exchange chromatography and precipitation. (See, e.g., page 575, last paragraph)

The reference differs from the claimed invention in that the enzyme is not derived from *Proteus* or *Providencia*. However, Swajcer *et al.* disclose that at least *Providencia* PCM 1270 and PCM 1298 as well as *P. mirabilis* PCM 1353 are well known in the art to be suitable bacteria for the bioconversion of amino acids to the corresponding keto acid. (See, e.g., Page 410, table 1 and col. 2), thus suggesting that the requisite enzyme is produced. From Table 2 it can be seen that the amino oxidase produced by at least *Providencia* PCM 1298 bioconverts L-tyrosine, an amino acid having polar but uncharged R groups, which constitutes a structurally similar substrate to L-glutamine. Therefore, one of ordinary skill in the art would reasonably have expected the bioconversion of glutamine, which is a structurally similar amino acid, i.e., an amino acid having polar but uncharged R groups to the respective keto acid, i.e., 2-ketoglutaramate by the specific strains identified as well as by other members of *Proteus* or *Providencia*. Note also the use of an immobilized catalyst or cells as well as the use of catalase in the process (See, e.g., page 412, col. 1).

The optimization of conditions identified as result-effective variables cited in the references, such as the concentration and physical state of glutamine, as well as the pH would have been prima facie obvious to a person having ordinary skill in the art, since they are parameters routinely adjusted by those of ordinary skill in this art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the process of Meister by substituting snake venom compositions with bacterial cells or biocatalysts obtained from *Providencia* or *Proteus*, including *Providencia* PCM 1270 and PCM 1298 as well as *Proteus mirabilis* PCM 1353 as suggested by the teachings of Swajcer *et al.* for the expected benefit of maximizing the yield of the useful plant growth regulator 2-ketoglutaramate in a simple and cost effective manner.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

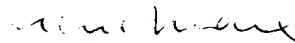
No claim is allowed.

Art Unit: 1651

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is before final (703) 872-9306 and after final, (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service whose telephone number is (703) 308-0198 or the receptionist whose telephone number is (703) 308-1235.


Irene Marx
Primary Examiner
Art Unit 1651